



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/676,272

09/30/2003

Andrew R. Ferlitsch

SLA1319

6569

50735

7590

09/22/2008

MADSON & AUSTIN

15 WEST SOUTH TEMPLE

SUITE 900

SALT LAKE CITY, UT 84101

EXAMINER

BLAIR, DOUGLAS B

ART UNIT

PAPER NUMBER

2142

MAIL DATE

DELIVERY MODE

09/22/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/676,272	<b>Applicant(s)</b> FERLITSCH, ANDREW R.	
	<b>Examiner</b> DOUGLAS B. BLAIR	<b>Art Unit</b> 2142	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 17 June 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

## **DETAILED ACTION**

### ***Response to Amendment***

Claims 1 and 9-24 are amended. Claims 1-24 are currently pending. The applicant's amendments have overcome the previous Specification Objection, the rejections based on 35 USC section 101, and 35 USC section 112.

### ***Response to Arguments***

Applicant's arguments filed 6/17/2008 have been fully considered but they are not persuasive. The applicant's remarks are not in line with the scope of the independent claims.

The applicant argues that the cited portion of Lacome does not disclose, nor can the applicant find any portion of Lacome that discloses "network address of a second data file associated with and including the network address of the peripheral device." In response, the Examiner agrees that Lacome does not teach such a feature and points out that the language of the claim does not require such a feature. Claim 1 requires "reading a first data file of the server device, said first data file including at least one of (a) the network address of the peripheral device, and (b) a network address of a second data file associated with and including the network address of the peripheral device". The cited embodiment meets claim requirement (a) and therefore satisfies the "at least one" language of the claims.

Next the applicant argues that Lacome does not disclose, "comparing portions of at least one of said first and second data files with a predetermined data formatting pattern indicative of a network address". The Examiner disagrees, because the data file mentioned in the cited embodiment of Lacome reads on the first data file because an address is clearly present in the

Art Unit: 2142

data file. Because Lacome teaches the claimed first data file, Lacome satisfies the limitation of at least one of a first and second data file.

Even if the applicant were to amend the independent claims to require both the first and second data files the claims would still not be patentable for the reasons given in the rejection of claim 4.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 9-11, and 17-19 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent Number 6,889,252 to Lacome D'Estalensx (hereinafter referred to as Lacome).

As to claim 1, Lacome teaches a method for communicating between a client device and a peripheral device over a network that includes the peripheral device, the client device, and a server device adapted to control the peripheral device, the peripheral device having a network address which is not known to the client device, the method comprising: determining the network address of the peripheral device, wherein determining includes reading a first data file of the server device, said first data file including the network address of the peripheral device and comparing portions of at least one of said first and second data files with a predetermined data formatting pattern indicative of a network address; addressing the peripheral device using

Art Unit: 2142

the determined network address of the peripheral device; and communicating directly with the peripheral device, thereby bypassing the server device (See alternate embodiment in Abstract and corresponding disclosure. The applicant's specification features no limiting definition of a "data file").

As to claims 2 and 3, Lacome clearly recognizes a pattern of an address otherwise it would not have been able to recognize the address to use it.

Claims 9-11 and 17-19 are rejected for the same reasons claims 1-3.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 4-8, 12-16, and 18-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Number 6,889,252 to Lacome D'Estalens in view of U.S. Patent Application Publication Number 2002/0059489 by Davis et al.

As to claim 4, Lacome teaches the method of claim 1; however Lacome does not teach the redundancy of having a file with an address to another file.

Davis teaches an addressable data file containing a list of printers including their addresses (paragraph 31).

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of Lacome regarding the addressing of printers

Art Unit: 2142

with the teachings of Davis regarding an addressable data file that contains printer addresses because a data file containing printer addresses allows for a central location for maintaining printer data.

As to claims 5-8, Lacome teaches recognizing an address as discussed and testing as claimed in that once the user tries to use the address, the user will be "testing" it.

Claims 12-16 and 18-24 are rejected for the same reasons as claims 4-8.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOUGLAS B. BLAIR whose telephone number is (571)272-3893. The examiner can normally be reached on 9:00am-5:30pm.

Art Unit: 2142

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Caldwell can be reached on (571) 272-3868. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Andrew Caldwell/  
Supervisory Patent Examiner, Art Unit  
2142

DBB